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IN THE

Supreme Court of the United States

October Term, 1964

No. [redacted] 11

WILLIAM T. GRAHAM, and GRAHAM PLOW, INC.,
Petitioners,

v.

JOHN DEERE COMPANY OF KANSAS CITY, and
DEERE & COMPANY, *Respondents*

Amicus Curiae Brief Of The Patent, Trade-Mark And Copyright Section Of The State Bar Of Texas (With The Consent Of The Board Of Directors Of The State Bar Of Texas)

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SUBJECT INDEX

	Page
I. Preliminary Statement	1
II. Argument	2
Summary of Argument	2
Point A - The legislative history of the second sentence of §103 clearly reveals the legislative intent to eliminate the "flash of creative genius" test of the *Cuno* case	3
Point B - Point A above is supported by the opinions of many Courts	5
Point C - The elimination of the "flash of creative genius" test by §103 is in the public interest	9
III. Conclusion	9
Certificate of Service	10

INDEX OF AUTHORITIES

CASES	Page
Cuno Engineering Corp. v. Automatic Devices Corp., 314 U.S. 84, 62 S.Ct. 37, 86 L.Ed. 58 (1941)	2
E. J. Brooks Co. v. Stoffel Seals Corp., 266 F.2d 841, 121 USPQ 333 (2 Cir. 1959), cert.den. 361 U.S. 883	5
L-O-F Glass Fibers Co. v. Watson, Comr.Pats., 228 F.2d 40, 107 USPQ 197 (Ct. App. D.C. 1955)	9
Lyon v. Bausch & Lomb Optical Co., 224 F.2d 530, 106 USPQ 1 (2 Cir. 1955), cert.den. 350 U.S. 911	5, 9

CASES	Page
Marvel Specialty Co., Inc. v. Bell Hosiery Mills, Inc., 330 F.2d 164, 141 USPQ 269 (4 Cir. 1964), cert.den. 13 L.Ed.2d 175 (No. 396, Nov. 9, 1964)	8
Plax Corp. v. Precision Extruders, Inc., 239 F.2d 792, 112 USPQ 150 (3 Cir. 1957)	7
Reiner v. I. Leon Co., Inc., 285 F.2d 501, 128 USPQ 25 (2 Cir. 1960), cert.den. 366 U.S. 929	6
R. M. Palmer Co. v. Luden's Inc., 236 F.2d 496, 111 USPQ 1 (3 Cir. 1956)	7
FEDERAL CONSTITUTION AND STATUTES	
United States Constitution, art. I, sec. 8, cl. 8	9
Patent Act of July 19, 1952, c. 950, §1, 66 Stat. 798, 35 U.S.C. §103 (1958)	2, 3, 9
MISCELLANEOUS	
2 U. S. Code Cong. & Ad. News, 82nd Congress, Second Session, 1952, at p. 2513	4

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I.

PRELIMINARY STATEMENT

The written consent of all parties to this case to the filing of this brief has been obtained and filed with the Clerk.

In this case the District Court found the patent valid and infringed. The Eighth Circuit Court of Appeals reversed, holding that since the District Court failed to apply the proper legal test of invention, its finding of patentability was induced by an erroneous view of the law. The decision of the Eighth Circuit Court of Appeals was based upon the test announced by this Court in *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 62 S.Ct. 37, 86 L.Ed. 58 (1941).

It is the purpose of this amicus curiae brief to present for this Court's consideration information with respect to the legislative history of §103 of the Patent Codification Act (Title 35, U.S.C.) and subsequent opinions of the courts which, we believe, establish that the "flash of creative genius" test of the *Cuno* case of 1941 was eliminated by the second sentence of §103 of the Patent Codification Act of 1952. 66 Stat. 798, 35 U.S.C. §103 (1958).

II.

ARGUMENT

Summary of Argument

The legislative intent of the Congress to eliminate the "flash of creative genius" test announced in the *Cuno* case is clearly established by the second sentence of §103, the legislative history thereof and subsequent opinions of the courts.

Point A

The legislative history of the second sentence of §103 clearly reveals the legislative intent to eliminate the "flash of creative genius" test of the Cuno case.

Obviously, the legislative intent was to effect a substantive change in the law by excluding the test in the second sentence.

Section 103 is as follows:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *Patentability shall not be negatived by the manner in which the invention was made.*" (Emphasis ours.)

The House and Senate Reports, including the Reviser's Note forming a part thereof, are the same. *In the Reviser's Note the first and second sentences of §103 are distinguished as follows:* (35 U.S.C. §103 [1958]).

> "There is no provision corresponding to the first sentence explicitly stated in the present statutes, but the refusal of patents by the Patent Office, and the holding of patents invalid by the Courts, on the ground of lack of invention or lack of patentable novelty has been followed since at least as early as 1850. This paragraph is added with the view that an explicit statement in the statute may have some stabilizing effect,

and also to serve as a basis for the addition at a later time of some criteria which may be worked out."

"The second sentence states that patentability as to this requirement is not to be negatived by the manner in which the invention was made, that is, it is immaterial whether it resulted from long toil and experimentation or from a flash of genius." (Emphasis ours.)

In the commentary by Mr. Charles J. Zinn, the House Committee's law revision counsel, the following statement is made: (2 U.S. Code Cong. & Ad. News, 82nd Congress, Second Session, 1952, at p. 2513).

"Section 103 is a restatement of the rule invalidating patents for lack of invention or lack of patentable novelty which has long been recognized by the Courts and other authorities but has not before been spelled out in the statute.

"The second sentence of this section providing that patentability shall not be negatived by the manner in which the invention was made eliminates the 'flash of genius' concept that has been considered as an essential element of patentability since the Cuno case. In that case (Cuno Engineering Corp. v. Automatic Devices Corp., 314 U.S. 84, 62 S.Ct. 37, 86 L.Ed. 58) *the Supreme Court held that 'the new device, however useful it may be, must reveal the flash of creative genius, not merely the skill of the calling'. The patentability of an invention resulting from arduous experimentation will not be negatived solely because it does not meet that concept."* (Emphasis ours.)

It thus appears that §103 should be construed to mean that if the differences between the patented subject matter and the prior art are such that the subject matter would not have been obvious to one skilled in the art at the time

the alleged invention was made, the patent is valid, and it is not necessary that the patented invention be the result of a "flash of creative genius."

Point B

Point A above is supported by the opinions of many Courts.

In *Lyon v. Bausch & Lomb Optical Co.*, 224 F.2d 530, 106 U.S.P.Q. 1 (2 Cir. 1955), cert. den. 350 U.S. 911, Judge Learned Hand said (page 535 of 224 F.2d):

> "The Courts of Appeal have very generally found in the recent opinions of the Supreme Court a disposition to insist upon a stricter test of invention than it used to apply * * *"

and, with reference to the *Cuno* case (page 536 of 224 F.2d):

> "* * * which in expression probably was the furtherest departure * * *."

In *E. J. Brooks Co. v. Stoffel Seals Corp.*, 266 F.2d 841, 121 U.S.P.Q. 333 (2 Cir. 1959), cert. den. 361 U.S. 883, Judge Lumbard in his dissenting opinion said (page 846 of 266 F.2d):

> "The establishment of a more liberal standard than the 'flash of creative genius' doctrine enunciated in the Cuno case was apparently one of the principal reasons why Congress passed the 1952 Patent Act, 35 U.S.C. §101 ff., especially §103. See e.g. Reviser's Note to §103, 2d Para.; Note, 44 Georgetown L.J. 100 (1955); Harris, Some Aspects of Legislative Intent of the Patent Act of 1952, 23 Geo. Wash. L.Rev. 658, 676 ff.

(1955). We so held in Lyon v. Bausch & Lomb Optical Co., supra, where the Cuno decision was cited as 'the furthest departure' (224 F.2d 536) from the test of Hotchkiss v. Greenwood, 1851, 11 How. 248, 267, 13 L.Ed. 683, to which the 1952 enactment was held to have returned devoid of intervening glosses."
* * *

"Thus we have recognized that the 1952 Patent Act has overruled Picard v. United Aircraft Corp., 2 Cir., 1942, 128 F.2d 632, and that Congress has made it clear that what was said in Cuno Engineering Corp. v. Automatic Devices Corp., 1941, 314 U.S. 84, 91, 62 S.Ct. 37, 87 L.Ed. 58, about a 'flash of creative genius' was not a proper test of invention."

And (pages 846-47 of 266 F.2d):

"In my view the citation of the Cuno case in Judge Clark's footnotes is apt to be misleading as the implications of its 'flash of creative genius' phrase, whether dictum or not, has been repudiated by the paramount authority of the Congress. Other circuits which have expressly adopted the analysis of Lyon v. Bausch & Lomb Optical Co., supra, are the District of Columbia, L-O-F Glass Fibers Co. v. Watson, 1955, 97 U.S. App. D.C. 69, 228 F.2d 40, 47 and note 14; Third Circuit, R. M. Palmer v. Luden's, Inc., 1956, 236 F.2d 496, 500; Fourth Circuit, Brown v. Brock, 1957, 240 F.2d 723. Only the First Circuit appears to have considered and rejected it. See, e.g., Hawley Products Co. v. United States Trunk, 1958, 259 F.2d 69."

In *Reiner v. I. Leon Co., Inc.*, 285 F.2d 501, 128 U.S.P.Q. 25 (2 Cir. 1960), cert. den. 366 U.S. 929, Judge Hand said (page 503 of 285 F.2d):

"There can be no doubt that the Act of 1952 meant to change the slow but steady drift of judicial de-

> cision that had been hostile to patents which made it possible for Mr. Justice Jackson in dissent to speak of the 'strong passion in this Court for striking them' (patents) 'down so that the only patent that is valid is one which this Court has not been able to get its hands on.' Jungerson v. Ostby & Barton Co., 335 U.S. 560, 572, 69 S.Ct. 269, 274, 93 L.Ed. 235. That was in 1945, while the test laid down in Hotchkiss v. Greenwood, 11 How. 248, 266, 13 L.Ed. 683, still had a nominal authority, of which little remained in actual application. We still cannot escape the conclusion—as we could not when Lyon v. Bausch & Lomb, supra, was decided in 1955—that Congress deliberately meant to restore the old definition, and to raise it from a judicial gloss to a statutory command."

In *R. M. Palmer Co. v. Luden's Inc.*, 236 F.2d 496, 111 U.S.P.Q. 1, (3 Cir. 1956), the Court *sitting en banc* said in an opinion by Judge Kalodner (page 499 of 236 F.2d):

> "The provisions of Section 103, 35 U.S.C., 1952 Ed., as set forth in footnote 3, are new. The purpose of the provisions as stated by the Reviser is to achieve a stabilizing effect, and to render immaterial whether the invention resulted from 'flash of genius'."

and (page 500 of 236 F.2d):

> "There is no longer any doubt that the 'flash of genius' has been laid to rest."

In *Plax Corp. v. Precision Extruders, Inc.*, 239 F.2d 792, 112 U.S.P.Q. 150 (3 Cir. 1957), Judge Biggs said at page 794:

"We enunciated our interpretation of section 103 in R. M. Palmer Co. v. Luden's, Inc., 3 Cir. 1956, 236 F.2d 496, and of recent date in Newburgh Moire Co., Inc. v. Superior Moire Co., Inc., 3 Cir., 1956, 237 F.2d 283. We need not repeat in detail here what was said there. It is not necessary that an invention result from a 'flash of genius.' We think that Ferngren's work involved 'more ingenuity * * * than the work of a mechanic skilled in the art'."

In *Marvel Specialty Co., Inc. v. Bell Hosiery Mills, Inc.*, 330 F.2d 164, 141 U.S.P.Q. 269, (4 Cir. 1964), cert. den. 13 L.Ed.2d 175 (No. 396, Nov. 9, 1964), Judge Boreman said (page 169 of 330 F.2d):

"The extent to which the enactment of section 103 of the statute altered prior law is not altogether clear. See Berry Brothers Corporation v. Sigman, 317 F.2d 700, 704, (4 Cir. 1963); Triumph Hosiery Mills, Inc. v. Alamance Industries, Inc., 299 F.2d 793, 800, (4 Cir.) cert. denied, 370 U.S. 924, 82 S.Ct. 1566, 8 L.Ed.2d 504 (1962). It is apparent, however, that something less than a 'flash of genius' or 'inventive genius' may fulfill the mandate of the statute. Berry Brothers Corporation v. Sigmon, supra; Reiner v. I. Leon Co., 285 F.2d 501, (2 Cir. 1960) (L. Hand), cert. denied, 366 U.S. 929, 81 S.Ct. 1649, 6 L.Ed.2d 388 (1961). A number of cases, both before and after enactment of the statute, have undertaken to comprehensively set forth the standard of invention to be used as a test for determining patent validity. When the mass of verbiage has been distilled, however, we have little more to giude us than the test which is incorporated in section 103, that is, whether, in view of the prior art, the subject matter of the patent would have been obvious at the time of the invention to a person having ordinary skill in the art."

In *L-O-F Glass Fibers Co. v. Watson, Comr. Pats.*, 228 F.2d 40, 107 U.S.P.Q. 197 (1955), the Court of Appeals for the District of Columbia cited with approval Judge Learned Hand's opinion in *Lyon v. Bausch & Lomb Optical Co.*, 224 F.2d 530, 535-36, 106 U.S.P.Q. 1, 6-7 (2d Cir. 1955).

Point C

The elimination of the "flash of creative genius" test by §103 is in the public interest.

The basic constitutional purpose of our patent system is "to promote the progress of science and useful arts". (Constitution Article I, Section 8, Clause 8) The military power and industrial prosperity of our nation are built upon substantial advances in science and useful arts. Therefore, the public interest requires that inventors be encouraged to make substantial advances.

To tell the inventors of our nation that they must have a "flash of creative genius" to obtain a patent, even though they make a substantial advance in the art, is to discourage invention and thereby discourage the progress of science and useful arts. So the Congress acted in the public interest when it enacted §103 to eliminate the "flash of creative genius" test.

III.

CONCLUSION

It is therefore respectfully suggested that this case presents a need for a decision by this Court that the "flash

of creative genius" test of the *Cuno* case has been eliminated by §103 of the Patent Codification Act.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that copies of the foregoing AMICUS CURIAE BRIEF OF THE PATENT, TRADE-MARK AND COPYRIGHT SECTION OF THE STATE BAR OF TEXAS (WITH THE CONSENT OF THE BOARD OF DIRECTORS OF THE STATE BAR OF TEXAS) were served in accordance with Rule 33 by mailing such copies, air mail postage prepaid, to Claude A. Fishburn, Esq., and Orville O. Gold, Esq., counsel for petitioner, at Suite 1217 Commerce Trust Building, Kansas City, Missouri, and to S. Tom Morris, Esq., counsel for respondent, at Suite 630 Amarillo Building, Amarillo, Texas; this _____ day of _____, 1965.

_____

J. Vincent Martin